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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,658	07/16/2003	Arno Schmuck	07244-00141-US	1458
23416	7590	11/14/2006	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP			LABAZE, EDWYN	
P O BOX 2207			ART UNIT	PAPER NUMBER
WILMINGTON, DE 19899			2876	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/620,658	SCHMUCK ET AL.
	Examiner EDWYN LABAZE	Art Unit 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 August 2006.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 and 10-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 8/29/2006.
2. Claims 1-8 and 10-18 are presented for examination.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haghiri et al. (U.S. 5,888,624) in view of Ludwig et al. (US 2002/0022143).

Re claims 1, 17: Haghiri et al. discloses data carrier [a paper IC card 3] with an electronic module 1 {as shown in fig. # 1} and a method for producing the same, which includes in that an image [as broadly claimed and interpreted by the examiner, Shimada discloses means of providing a sheet with a printed image {represented as a reference 2 in fig. # 1} before punching (col.8, lines 11+; col.9, lines 33+; col.10, lines 43+)] is arranged on at least one main surface of the paper core/base [as shown in figs. # 7-8; wherein the structure of the card bodies 3 consisting of exclusively of paper and cardboard], at least 5% [i.e. a portion up to the entire surface] of at least one main surface are covered by a seal and the chip1 is covered on both main surfaces with a seal or a plastics layer [during lamination] (see col.6, lines 25+; col.10, lines 2+).

Haghiri et al. fails to teach that the adhesion between the seal and the paper is stronger than the cohesion with the paper core.

Ludwig et al. teaches separable adhesive layer {to secure cards, such as credit cards, check cards and the like}, laminate and method for making the same, which includes two different adhesive layers 40 & 42, wherein the adhesive layers 40/42 face backing layers 38 & 36 respectively and adhesive 42 is made of a relatively thick base with considerably stronger bonding than adhesive 40 (paragraphs 0017+; 0039-0041).

In view of Ludwig et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art the invention was made to employ into the teachings of Haghiri et al. a stronger external adhesive layer securing the seal/laminated layer than any internal adhesive layer within the body of the card so as to provide added security to the card. Furthermore, such modification would provide an indication of tampering upon removal of the seal/laminated layer, and prohibit detaching the adhered layer without noticeable damage. Moreover, such modification would have been an obvious extension as taught by Haghiri et al., therefore an obvious expedient.

Re claims 2-3: Haghiri et al. teaches an apparatus and method, wherein at least one seal consists of plastics or a plastics-coated paper [also known in the art as "laminating technique" and used as a cover layer. Herein and incorporated in the specs, Haghiri et al. teaches a cover layer 9 {and other references such as EP-B1 0 140 230, EP-A1 0 493 738} and method wherein the card body consisting of plastic layer through the laminating technique; col.1, lines 10+; col.2, lines 4+; col.3, lines 60+). Furthermore, Haghiri et al. teaches means of coating the layers using a silicone band 29 (col.5, lines 1+; col.8, lines 9+; col.10, lines 44+).

Re claims 4-5: Haghiri et al. discloses an apparatus and method, wherein the paper core comprises at least one image-receiving [herein Haghiri et al. discloses markings on the surface of

the card, which could be in the form of an image] layer on at least one main surface and the image-receiving layer comprises a microporous or gelatine-containg layer (col.9, lines 33-67).

Re claims 9-11: Haghiri et al. teaches an apparatus and method, that it is provided on at least one main surface with a seal which is at least 5% smaller than the main surface, wherein the seal extends at no point to the edge of the card 3, and the seal covers the recess [herein as a two-step gap 15/19 as shown in figs. # 3-4, 12, 6] for the chip or electronic module 1 on at least one side (as shown in fig. # 18; col.8, lines 60-67; col.9, lines 1+).

Re claims 12-13: Haghiri et al. teaches an apparatus and method, wherein the paper core contains at least one recess [herein as a two-step gap 15/19 as shown in figs. # 3-4, 12, 6] with fine structures to accommodate the chip 1 (col.4, lines 50+).

Re claims 14-15: Haghiri et al. discloses an apparatus and method, wherein the covered on at least one main surface at least over its entire area with a plastics layer [using the laminating technique through thermal roll {as shown in figs. # 4 & 12} or punch out of the edges {as seen in fig. # 18}, which projects beyond all the card's edges and the projecting margins of the two layers are welded [as seen in fig. # 18] together (col.2, lines 5-20; col.4, lines 10+; col.8, lines 61-67; col.9, lines 1+).

Re claim 16: Haghiri et al. teaches an apparatus and method, comprising an image is produced on the paper core, a recess for the chip is then created, the chip or electronic module 1 is inserted once the recess [herein as a two-step gap 15/19 as shown in figs. # 4, 12, 6, 17c] has been covered on one side with the seal {such as adhesive layers 5, 21} and then the second side of the recess is covered with the seal {such as adhesive layers 9, 23} or a plastics layer (col.4, lines 40-67).

5. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haghiri et al. (U.S. 5,888,624) as modified by Ludwig et al. (US 2002/0022143) above in claim 1, and further in view of Fraser et al. (U.S. 4,855,583).

The teachings of Haghiri et al. as modified by Ludwig et al. have been discussed above.

Haghiri et al. as modified by Ludwig et al. fails to teach an image-forming layer comprising a photographic layer.

Fraser et al. discloses structure and method of making combination proximity/insertion identification cards, which includes an image-forming layer 434 comprising a photographic layer (as shown in fig. # 4 of Fraser et al.; col.5, lines 65+; col.7, lines 32+; col.10, lines 15+).

In view of Fraser et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Haghiri et al. as modified by Ludwig et al. an image-forming layer comprising a photographic layer so as to authenticate the image of the cardholder. Furthermore, such modification is well known in the art [as exemplified by the examiner in U.S. reference 5,410,642 of Hakamatsuka et al.; see figs. # 3-5, 13, 16, 18] and would provide adequate security of the card render very visible any falsification/tampering of the image/photograph on the card. Moreover, such modification would have been an obvious extension as taught by Haghiri et al. as modified by Ludwig et al., therefore an obvious expedient

#### *Response to Arguments*

6. Applicant's arguments filed 8/29/2006 have been fully considered but they are not persuasive.

The applicant argues that the present invention provides security features that are not suggested by Haghiri and the security features provide an identity card with a very high anti-counterfeiting security (see page 6, 4<sup>th</sup> paragraph of applicant's arguments).

The examiner respectfully disagrees with the applicant's remarks, because there are no such limitations "security features with a very high anti-counterfeiting" in the recited claims.

The applicant argues that a person skilled in the art would not have combined Haghiri and Ludwig to modify an identity card to arrive at the present invention (see page 7, 2<sup>nd</sup> paragraph of the applicant's arguments).

The examiner respectfully disagrees with the applicant's remarks. The applicant acknowledges that the adhesive has a considerably stronger bonding to the backing layer, the fact that the applicant uses the adhesion for a different purpose does not alter the conclusion that its use in a prior art device would be *prima facie* obvious from the purpose disclosed in the reference; *In re Linter*, 173 USPQ 560; and that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
November 10, 2006



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